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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,286	08/06/2001	Sauro Macerini	N-6811	9041

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WADDEY & PATTERSON  
414 UNION STREET, SUITE 2020  
BANK OF AMERICA PLAZA  
NASHVILLE, TN 37219

EXAMINER
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NGUYEN, DONGHAI D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/923,286

Applicant(s)

MACERINI, SAURO

Examiner

Donghai D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) 20-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other:

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## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group I and Species 1 claims 1-19 in Paper No. 7 is acknowledged.

### *Drawings*

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "7" and "8" have both been used to designate "half-turns". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "7" has been used to designate both "shaped segments" and "half-turns" and reference character "8" has been used to designate both "turns" and "half-turns". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a) because they fail to show conductive tracks 24, in Fig. 11 as described in the specification (page 13, line 4). Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Note: there are many reference characters that use the specification could not be found in the Figure(s) that the specification refers to, such as, "7F", etc.

***Specification***

5. The disclosure is objected to because of the following informalities: the word "simple" (page 1, lines 10) should be --single--. The phrase "soldering pads 24" should be --soldering pads 23, 25--. There are too many inconsistency reference characters in the specification that not match to the drawings, for example: "through hole 5, as show in Fig. 4" (page 10, line 1), etc.

Appropriate correction is required.

6. Claims 3-10 are objected to because of the following informalities: the phrase "of either of claim 2" is vague. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 7-10 and 16-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, such as: "connecting ... layer" (claims 7 and 16, lines 2-3). It is unclear what and where the "two electrically insulated layers" Applicant refer to. Are they the walls created by the inner spacer and the central through hole?

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. Claims 1-19 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 1,071,103 to Macerini.

Regarding claim 1, Macerini discloses a method of producing an electrical component, comprising the steps of: folding a plurality of segments (7) of electrically conductive material partially around a container to form a plurality of half-turns (8); and connecting the plurality of half-turns to the container (1).

Regarding claim 11, Macerini discloses a method of producing an electrical component, comprising the steps of: folding a plurality of segments (7) of electrically conductive material into a plurality of u-shaped half-turns (8); and connecting the plurality of half-turns to a container (1).

Regarding claim 2, Macerini discloses the step cutting the plurality of segments out of a sheet of electrically conductive material so that the segments are arranged in a dial-shaped pattern with one end of each segment connected to an inner ring and another end of each segment connected to an outer ring (Fig. 3); and detaching each segment from the inner and outer rings (col. 6, lines 12-15).

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Regarding claim 3, Macerini discloses the step of folding the plurality of segments includes the steps of: folding a first portion connected to an intermediate portion of each segment down against a first upper edge of the container; and folding a second portion connected to the intermediate portion of each segment down against a second upper edge of the container (Fig. 4).

Regarding claim 4, Macerini discloses folding a third portion connected to the first portion of each segment inward against or outward away from a first lower edge of the container; and folding a fourth portion connected to the second portion of each segment inward against or outward away from a second lower edge of the container (4A and 4B).

Regarding claim 12, Macerini discloses the method of claim 11, further comprising the step of punching the plurality of segments from a sheet of electrically conductive material (col. 6, lines 12-15).

Regarding claim 13, Macerini discloses the method of claim 11, further comprising the steps of: forming the plurality of segments out of a strip of electrically conductive material; and detaching each segment individually from the strip of material (Col. 6, lines 7-15).

Regarding claims 5 and 14, Macerini discloses the step of inserting a ferro-magnetic core (15) into the container (Fig. 8).

In regard to claims 6 and 15, Macerini discloses the step of wrapping an electrically conductive wire (31) around the ferro-magnetic core (col. 8, lines 2-4).

As best as understood of claims 7 and 16, Macerini discloses the step of connecting the plurality of half-turns to the container comprises the step of connecting the plurality of half-turns in two electrically insulated layers (Fig. 12 and col. 8, lines 8-13).

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Regarding claims 8 and 17, Macerini discloses the step of connecting the plurality of half-turns in two electrically insulated layers comprises the steps of: integrating a portion of the plurality of half-turns into the container; and attaching the remaining half-turns to an outer surface of the container (Fig. 5).

Regarding claims 9 and 18, Macerini discloses the step of connecting the combination of the container and the plurality of half-turns to a mounting structure by connecting the plurality of half-turns to a plurality of electrically conductive tracks on the mounting structure (22/26), the half-turns and the conductive tracks forming a plurality of electrically conductive turns (Figs. 8 and 9).

Regarding claims 10 and 19, Macerini discloses the step of connected the turns in series, parallel, or a combination of series and parallel (col. 9, lines 18-26).

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

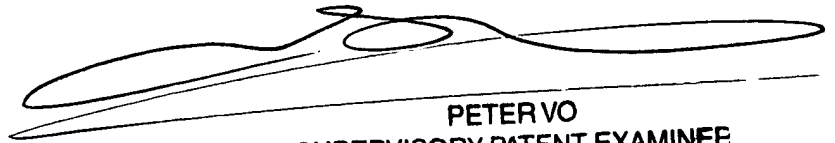
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donghai D. Nguyen whose telephone number is (703) 305-7859. The examiner can normally be reached on Monday-Friday (9:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7307 for regular communications and (703) 305-3579 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

DN  
March 18, 2003

A handwritten signature in black ink, appearing to read 'PETER VO', written over a horizontal line.

PETER VO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700